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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,582	07/21/2003	James I. Livingstone	A894610US	3395
23971	7590	10/11/2005	EXAMINER	
BENNETT JONES C/O MS ROSEANN CALDWELL 4500 BANKERS HALL EAST 855 - 2ND STREET, SW CALGARY, AB T2P 4K7 CANADA			COLLINS, GIOVANNA M	
			ART UNIT	PAPER NUMBER
			3672	
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

ML

Office Action Summary

Application No.

10/622,582

Applicant(s)

LIVINGSTONE, JAMES I.

Examiner

Giovanna M. Collins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-41,43-70,73-166 and 168-171 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 163-166 and 168-171 is/are allowed.
- 6) ☒ Claim(s) 1,5-8,15,22,25-41,43-53,55-64,68,75-82,86,91,98,100-119,121-148,150-152 and 154-162 is/are rejected.
- 7) ☒ Claim(s) 9-14,16,17,19-21,23,24,54,65-67,69,70,73,74,83-85,87-90,92-97,99,120,149 and 153 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The indicated allowability of claims 1, 5-8, 15, 18 and 25 are withdrawn in view of the newly discovered reference(s) to Hooper '426. Rejections based on the newly cited reference(s) follow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 26-27, 29, 32-34, 37, 43-44, 146, 151, 152, 155-158, 162 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 19, 27, 31, 39, 40, 42, 43 of copending Application No. 10/346,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 26 –41,43-51, 98,100-119,121-148,150,152,154,156-157,159-162 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3,8, 14-21,23,28,30-46,51-54,64 of U.S. Patent No. 6854534. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the Patent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,5-8,15, 18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooper 4,534,426.

Referring to claims 1,5,6, and 18, Hooper discloses (fig. 2) a method for removing material from a well extending from a ground surface into a hydrocarbon formation having a pressure, comprising: (a) delivering into said well bore a concentric pipe string, said concentric pipe string comprising an inner pipe (at 11') having an inner space therethrough and an outer pipe (at 11) forming an outer annulus between said outer pipe and said inner pipe; (b) introducing (col. 5, lines 58-68) into said well bore at

Art Unit: 3672

a pressure substantially equal to or below said pressure of the formation a pressurized drilling fluid through said outer annulus and (c) removing solid particles and drilling fluid through the other of the said inner space to the surface of said well bore.

Referring to claims 7-8, Hooper discloses a discharging means that is a mud pump (17).

Referring to claim 15, Hooper discloses a clean out tool (20).

Referring to claim 22, Hooper discloses a venturi (at J).

5. Claims 52,56-59,61,68,75-76,78-79,81 and 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Sewell 2,537,605.

Referring to claims 52, 56-58,75-76,81 Sewell discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (3), said tubing string comprising an inside and outside forming an annulus between the outside of the drill string and a wall of said wellbore introducing into said well bore by mud pump (at 10) connected near the to top of the production string a pressurized drilling mud through annulus and removing said solid particles (at 9) and drilling mud through the inside of production tubing to the surface of said well bore, means (at 7) communication at top of tubing string with said inner space for removing drilling fluid and means (at 10) for introducing drilling mud.

Referring to claims 59 ,61,78-79, Sewell discloses a discharging means that is mud pump (at 10).

Referring to claims 68,86, Sewell discloses a cleanout tool (4).

6. Claims 52, 59, 75, and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Muncy 2,167,393.

Referring to claims 52, 75, 81, Muncy discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (18), said tubing string comprising an inside and outside forming an annulus between the outside of the drill string and a wall of said wellbore introducing into said well bore near the top of the production string a pressurized air (at 21) through annulus and removing said solid particles (at 9) and air through the inside of production tubing to the surface of said well bore and means (b) for introducing the air and means (at 22) for removing material and air.

Referring to claim 59, Muncy disclose a discloses a discharge means (B).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooper '426.

Hooper discloses the method of claim 1 but does not disclose a casing with perforations. However a casing having perforations is well known in the art. As it would be advantageous to have a casing to help support the well bore and perforation to allow the hydrocarbons in the formation to come into the casing, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclose by Hooper to have a casing with perforations.

9. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sewell '605

Sewell discloses the method of claim 1 but does not disclose a casing with perforations. However a casing having perforations is well known in the art. As it would be advantageous to have a casing to help support the well bore and perforation to allow the hydrocarbons in the formation to come into the casing, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclose by Sewell to have a casing with perforations.

10. Claims 55 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sewell '605

Sewell discloses the method of claim 1 but does not disclose coiled tubing. However coiled tubing is well known in the art. As one of ordinary skill in the art would be familiar with coiled tubing, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclose by Sewell coiled tubing.

Referring to claims 91, Sewell discloses a bottom hole assembly (at 4).

11. Claims 63-64 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muncy '393 in view of Sinclair ('515).

Referring to claims 63, Muncy discloses the method of claim 52 but does not disclose a suction means. Sinclair teaches (see Fig. 1) using a suction compressor to help remove a cleanout fluid (see col. 2, lines 59-60). As it would be advantageous to have a suction compressor to help the cleanout medium remove the material, it would be obvious to modify Muncy to have a suction compressor as taught by Sinclair.

Referring to claims 64 and 82, Sinclair teaches a suction compressor (see col. 2, lines 59-60)

12. Claims 62 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muncy ' 393 in view of McQueen '090.

Muncy discloses the apparatus and method of claims 59 and 75 and disclosed the clean out medium is air but does not disclose a discharging compressor. McQueen teaches that a compressor can be used to introduce pressurized air as a drilling fluid. As one of ordinary skill in the art would be familiar with using an compressor to introduce air, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus disclosed by Muncy to use a compressor as taught by McQueen.

Allowable Subject Matter

Claims 9-14, 16-17, 19-21, 23-24, 54, 65-70, 73-74, 83-85, 87-90, 92-97, 99, 120, 149, and 153 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 163-166 and 168-171 are allowed.

Response to Arguments

13. Applicant's arguments with respect to claims 1, 5-8, 15, 18, 22, 25, 52-53, 55-64, 68, 75-82, 86, and 91 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gmc


David Bagnell
Supervisory Patent Examiner
Technology Center 3670